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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,134	08/06/2001	Atle Hedloy	103176-0001C1	9141

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EXAMINER
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DELA TORRE, CRESCELLE N

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 10/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/923,134

Applicant(s)

HEDLOY, ATLE

Examiner

Crescelle dela Torre

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The ~~proposed drawing correction~~ <sup>Formal Drawings</sup> filed on 31 October 2001 <sup>are</sup> is: a) ☒ approved b) ☐ disapproved by the Examiner. <sup>Draftsperson</sup>
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This action is responsive to communications: Substitute Specification, filed on 9/7/01, Formal Drawings, filed on 10/31/01, Prior Art, filed on 11/7/01, and Preliminary Amendment, filed on 12/17/01.

This action is non-final.

Claims 1-18 are pending in this application. Claims 1 and 14 are independent claims. In the Preliminary Amendment, filed on 12/17/01, claim 2 was amended, and claims 9-18 were added.

This application is a continuation of 09/189,626, filed on 11/10/98, now U.S. patent 6,323,853.

The present title of the invention is "Method, System and Computer Readable Medium for Addressing Handling from a Computer Program".

### ***Priority***

1. Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. 09/189,626 under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be made in this application. In making such claim, applicant may simply identify the application containing the priority papers.

***Oath/Declaration***

2. The third page of the declaration, filed on 8/6/01, is missing. Please provide a copy of the missing page.

***Drawings***

3. The formal drawings were received on 10/31/01. These drawings are approved.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is not clear where in the specification the step of "automatically marking the first information to alert the user that the first information can be utilized in a second application program" is described. For instance, the specification describes at figure 3, and page 10, lines 12-17, that when the user hits the button marked "OneButton", the present invention performs retrieval, search, and insertion of address information associated with a name. However, it is not clear where the automatic marking step is described.

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6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2, 8, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, "an activation a device" is unclear.

As to claim 8, it is not clear whether applicant is claiming electromagnetic signals per se or a computer data signal embodied in a carrier wave.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. One reasonable interpretation of the claim is that it recites electromagnetic signals per se. Electromagnetic signals per se are non-statutory natural phenomena.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso (U.S. patent 6,085,201) in view of Pandit (U.S. patent 5,859,636).

As per claim 1, Tso teach a method of information handling within a document created using a first application, such as an e-mail application 20, at figure 2, comprising the steps of:

entering a first information in the first application program, at column 4, lines 32-35; and

responding to a user selection by inserting a second information into the document, the second information associated with the first information from a second application program, such as template engine 5, at column 6, line 66 to column 7, line 2.

Tso teaches the above steps of claim 1, but does not specifically teach automatically marking the first information to alert the user that the information can be used in a second application.

On the other hand, it is known in the art that information can be marked so that a user is informed of its possible use in other applications. For instance, Pandit teaches "recognition of text in a body of text as belonging to a predetermined class and performing an operation relevant to the recognized text" at column 1, lines 51-53. Pandit also teaches marked information, with highlighted text 11, 14, 16, at figures 1a-1f, and column 2, lines 5-6, 51, 64-65.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the accented text of Pandit in the invention of Tso because it allows for "transforming the text into an interface to other functions or operations".

As to claim 2, Tso teaches a user interface device, at column 3, lines 34-35.

As per claim 3, Tso teaches the following:

initializing the second application, at column 4, lines 48-51;

searching, using the second application, for the second information associated with the first information, at column 5, lines 7-17; and

retrieving the second information, at column 5, lines 42-48.

Tso also teaches displaying the second information [claim 4] at column 5, lines 42-44, and completing the first or second information [claim 5] at column 6, lines 6-10.

Regarding claim 6, Pandit teaches name information, at column 7, line 43.

As to claims 7 and 9-13, Tso teaches a computer readable medium, at column 8, lines 2-4.

Regarding claim 8, Pandit teaches electromagnetic signals propagating over a network, at column 5, lines 38-43.

As to claim 14, Tso teaches the following subject matter:

entering a first information in the first application program, at column 4, lines 32-35; and

responding to a user selection by performing an operation related to a second information, the second information associated with the first information from a second

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application program, such as template engine 5, at column 6, line 66 to column 7, line 2, and column 7, lines 14-25.

Tso teaches the above steps of claim 14, but does not specifically teach automatically marking the first information to alert the user that the information can be used in a second application.

On the other hand, it is known in the art that information can be marked so that a user is informed of its possible use in other applications. For instance, Pandit teaches "recognition of text in a body of text as belonging to a predetermined class and performing an operation relevant to the recognized text" at column 1, lines 51-53. Pandit also teaches marked information, with highlighted text 11, 14, 16, at figures 1a-1f, and column 2, lines 5-6, 51, 64-65.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the accented text of Pandit in the invention of Tso because it allows for "transforming the text into an interface to other functions or operations".

As to claim 15, Pandit teaches name information, at column 7, line 43, and operations selected from a group consisting of an e-mail, a telex, a fax, or a letter, at column 2, lines 39-41, 58-59, and column 2, line 67 to column 3, line 8.

Tso teaches entering additional data into a database [claim 16] at column 7, line 19, which is entered by a user [claim 17] at column 7, lines 14-25, and located within a document [claim 18] at column 6, lines 6-10, and figure 4.



**Conclusion**

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dugan et al (U.S. patent 5,375,200) teach graphic interaction between data and multiple applications.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Crescelle dela Torre whose telephone number is (703) 305-9782. The examiner can normally be reached on Monday-Thursday, from 8am-4pm, and on alternate Fridays, from 8am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (703) 308-0640. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for official communications; (703) 746-7238 for After Final communications; and (703) 746-7240 for non-official or draft communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

*C. dela Torre*  
CRESCELLE N. DELA TORRE  
PRIMARY EXAMINER